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SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			KYLE, CHARLES R	
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			3624	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/780,248

Applicant(s)

HARRIS, SCOTT C.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9-11 and 15-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-7,9-11 and 15-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

5-d-u

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 15-19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite the phrase “displaying information which allows entering a user to enter either one of...”, which does not clearly recite that entering occurs; it is viewed as not limiting. Also, the phrase “entering a user to enter either one of...” is nonsensical. Applicant argues that these Claims are amended similarly to Claim 5; the indefinite word “allow” is still present.

**Claim 29** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It recites the phrase “displaying information allowing a seller to select an amount of time...”, which does not clearly recite that sellers actually do select; it is viewed as not limiting. Applicant argues that these Claims are amended similarly to Claim 5; the indefinite word “allowing” is still present.

The Claims have been examined to the best of the Examiner’s ability given the condition of the Claims.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 5-8, 15-17 and 28-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a

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"useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In *re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on

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novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the *Freeman-Walter-Abele* test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001), non-precedential but cited for its reasoning.

In the present application, Claims 15-17 and 28-32 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. The Claims recite a network, which contrary to Applicant's assertion in Remarks need not comprise a machine. Applicant's attention is drawn to the concept of "networking" among people, which does not require a machine. The rejection of Claims 5-8 was withdrawn based on inclusion of the words "client" and "server", which clearly imply a client- server computer network. These are missing from Claims 15-17 and 28-32.

Steps of definition and bid submission and other recited steps could be performed manually. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which

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of the steps are being performed within the technological arts, such as incorporating a computer network or electronic network into the communicating steps; for example: “(a) communicating over a computer network a plurality of brand promotions...” The other claims could be similarly amended to include a computer network.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 15, 16 and 19** are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,012,045 *Barzilai et al.*

**With respect to Claim 15**, *Barzilai* discloses the invention as claimed including in a method, the steps of:

displaying an item for sale by auction over a network (Fig. 5);

and

displaying information to enter a bid for said item (Fig. 5, “Bid” button, Col. 12, lines 29-45, particularly, lines 39-41; See also Col. 12, line 29 to Col. 14, line 59).

Applicant appears to argue at Remarks that *Barzilai* does not disclose *both* the bid *and* the amount to win the auction (conjunctive). The Claim language is clearly in the *alternative*

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(either....or...), and so the disclosure of the displayed information to place a bid ("Bid" button) meets the requirements of the Claim. If Applicant intends that the Claim language require *both* the bid *and* the amount to win the auction, the Claim should be so amended.

**Concerning Claim 16**, *Barzilai* discloses automatic updating of sale items at Col. 10, line 34 to Col. 11, line 30.

**With respect to Claim 19**, *Barzilai* discloses the use of the Internet at Objects of the Invention.

**Claims 28** is rejected under 35 U.S.C. 102(e) as being anticipated by US 2001/0032175 *Holden et al.*

**With respect to Claim 28**, *Holden* discloses the invention as claimed, including in a method the steps of:

conducting an auction over a network by accepting bids for items, and establishing a highest bid for an item as winning bid (Summary of the Invention); and

treating a bid received within a predetermined period of time before an end time of an auction less favorably than bids received prior to said predetermined period (para. 83).

Applicant argues in Remarks that *Holden* does not disclose that bids are treated less favorably. This is incorrect. Because late arriving bids cause an auction extension, they are treated differently and less favorably than those earlier received.



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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,285,989

*Shoham* in view of *eBay Help : Basics : FAQ : Auction Formats*, hereinafter, *Formats*.

**With respect to Claim 5**, *Shoham* discloses the invention as claimed including in a method, the steps of:

Accepting bids from a plurality of users to submit bids for a specified item being auctioned (Col. 1, line 35 to Col. 2, line 3), said bids being submitted from any of a number clients (Fig. 2; Col. 11, lines 36-56) over a network (Fig. 2, ele. 113) to a server which collects said bids (Col. 5, lines 29-35); and

defining rules for actions in said auction (Col. 5, line 65 to Col. 9, line 27), said rules including at least a time when the action will take place, and an actual action that will take place at the defined time (Col. 6, lines 40-51; Col. 10, Col. 10, lines 26-45).

Further, see the discussion of Claim 8.

**Concerning Claim 6**, *Shoham* discloses bids to take place at a defined time at Col. 6, lines 40-51. Applicant argues that *Shoham* fails to teach bids to take place at defined times; the start time disclosed by *Shoham* at Col. 6, lines 40-51 exactly discloses a defined time for bids

**With respect to Claim 7**, *Shoham* discloses overriding a bid at Col. 2, lines 29-34. Applicant argues that *Shoham* fails to teach “override” but does not distinguish his concept of “override” from increasing a bid as taught by *Shoham*.

**With respect to Claim 8**, *Shoham* discloses the invention substantially as claimed. See the discussion of Claim 5. *Shoham* does not specifically disclose rules kept secret until a defined time. *Formats* discloses the reserve price auction at page 1” What I a Reserve Price Auction”, where a reserve price is kept secret until a defined time (the time at which bids meet or exceed

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the reserve price). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Shoham* with a secret rule, such as that of *Formats* because this would allow a seller to not sell at an unacceptably low price.

As to Applicant's argument regarding reserve prices and bidding rules, the Examiner simply notes that reserve price *is* a bidding rule; the two are therefore equivalent.

**Claims 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,285,989 *Shoham* in view of US 6,161,099 *Harrington et al.*

**With respect to Claim 9**, *Shoham* discloses the invention substantially as claimed, including in a method of conducting an auction over a network (Col. 2, line 50 to Col. 4, line 34), the steps of:

for any particular auction, sending information from a server computer to a local computer, which information enables the local computer to carry out some function associated with bidding on an item (Col. 5, lines 29-35);

making a decision accept or reject a new bid from a user (Col. 5, lines 29-35; Col. 6, lines 10-21) and sending information about the new bid to the server computer (Figs. 4, 7; Col. 12, lines 7-21).

*Shoham* does not specifically disclose the newly claimed limitations of transmitting highest bidder information to a local computer and accepting at a local computer based on comparing a local bid to highest bid information. *Harrington* discloses such offloading at Summary of the Invention, particularly, Col. 5, lines 20-42. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Shoham* with the distributed

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processing of *Harrington* because this would avoid server overloads and resulting auction delays. It would further have been obvious to not transmit unacceptable bids to the server because this would reduce unnecessary network traffic and avoid increased processing times.

**With respect to Claim 10**, *Shoham* does not specifically disclose accepting a bid after comparison to a highest bid. Official Notice is taken that it was old and well known at the time of the invention to perform such a comparison in an English auction to accept only bids higher than a current high bid. For example, it was known for an auctioneer to continually ask for increasing bids so as to maximize sellers take from a sale. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Shoham* to include such a comparison to obtain a new higher current bid because this would make an auction must profitable to a seller. As to the limitation of sending only improved bids, see the discussion of Claim 9.

**With respect to Claim 11**, *Shoham* discloses updating with new information at Col. 12, lines 78-21.

**Claims 12-14, 23-24 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,012,045 *Barzilai et al* in view of *Auction This!*.

**With respect to Claim 12**, see the discussion of Claim 15. *Barzilai* does not disclose an automatically winning bid price amount. *Auction This!* discloses this limitation at page 136, "Buy Price Auctions". It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Barzilai* to include the automatically winning bid price amount of

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*Auction This!* because this would allow a buyer to avoid bidding and the risk of loss by buying at such an assured price.

**With respect to Claim 13**, see the discussion of Claim 12 and *Auction This!* further discloses a reserve price at page 136.

**With respect to Claim 14**, determining whether a new bid was acceptable (higher than current bid) was old and well known at the time of the invention. *Barzilai* discloses displaying bids at Objects of the Invention. The claim limitations of Claim 14 recite only known and fundamental aspects of auction process.

**Concerning Claim 23**, see the discussion of Claim 12.

**With respect to Claim 24**, *Barzilai* discloses a web browser. Applicant argues that the references do not teach updating and refreshing a web browser. Applicant admits that *Barzilai* has a web browser; Official Notice is taken that it was old and well known to refresh a web browser. For example, the "Reload" button in the Netscape browser and the "Reload" button in the Microsoft Internet Explorer browser performed exactly this function.

**With respect to Claim 27**, see the discussion of Claims 23 and 14.

**Claims 25-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,012,045 *Barzilai et al* in view of *Auction This!* and further in view of US 6,415,268 *Dinwoodie*.

**Concerning Claims 25-26**, *Barzilai* discloses the invention substantially as claimed. See the discussion of Claim 23. *Barzilai* does not disclose the use of video to form view parts or streaming video. *Dinwoodie* discloses the use of such video in an auction at Col. 6, lines 19-29.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Barzilai* to sue video presentation of information because users obtain most information visually.

**Claims 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,012,045 *Barzilai et al* in view of US 5,847,971 *Lander et al*.

**Concerning Claim 17**, see the discussion of Claim 15. *Barzilai* does not specifically disclose that an item for sale is presented in a three-dimensional view. *Lander* discloses this limitation at Col. 4, lines 36-47. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Barzilai* to include such a display because this would allow a bidder to obtain a more complete appreciation of the appearance of an item to be bid on (All sides could be seen, not just one).

Applicant argues in Remarks that *Lander* does not display in an auction setting. The rejection was made over the two cited references in combination. The motivation to combine references makes clear that *Barzilai* is cited for auction elements and *Lander* is cited for display of three-dimensional views of auction objects.

**Claims 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,012,045 *Barzilai et al* in view of US 6,101,498 *Scaer et al*.

**Concerning Claim 18**, see the discussion of Claim 15. *Barzilai* does not specifically disclose that a screen tip is used to display information. *Scaer* discloses this limitation at

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Summary of the Invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Barzilai* to display bid amounts with the screen tips of *Scaer* because this would provide a simple and efficient way for a user to obtain bid data otherwise suitably hidden.

**Claims 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,285,989 *Shoham* in view of US 6,101,498 *Scaer et al.*

**With respect to Claim 20**, see the discussion of Claim 15. *Shoham* further discloses server and clients at Figs 2-4 and related text. *Shoham* does not specifically disclose the use of screen tips. *Scaer* discloses this limitation at Summary of the Invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Shoham* to display bid amounts with the screen tips of *Scaer* because this would provide a simple and efficient way for a user to obtain bid data otherwise suitably hidden.

**Claims 21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,285,989 *Shoham* in view of US 6,012,045 *Barzilai et al* and further in view of US 6,101,498 *Scaer et al.*

**Concerning Claim 21 (second Claim numbered 20)**, see the discussions set forth above. *Shoham* does not specifically disclose a current bid. Official Notice is taken that current bids were old and well known at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Shoham* to display a current bid

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because this would allow bidders know what amount must be bid to become current highest bidder.

**With respect to Claim 22**, see the discussions of Claims 19 and 20.

**Claim 29** is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0032175 *Holden et al.*

**With respect to Claim 29**, see the discussion of Claim 28. *Holden* does not specifically disclose that the predetermined time is defined by the seller. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such a seller option because this would give the seller control over the anti-sniping process disclosed by *Holden*.

**Claims 30 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0032175 *Holden et al* in view of US 6,499,018 *Alaia et al.*

**Concerning Claim 30**, *Holden* discloses the invention substantially as claimed. See the discussion of Claim 28. *Holden* does not specifically disclose that a bidder participating in bids earlier than near the auction end is identified. *Alaia* discloses this limitation at Fig. 8 and related text. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Holden* with the bidder identification of *Alaia* because this would indicate that the identified bidder was making good faith bids rather than sniping. Note that *Alaia* is concerned with auction closing times (see at least Abstract), as is *Holden*.

**With respect to Claim 32**, see the discussion of Claim 30.



### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14, 5, 7, 6, 8, 5 and 9, 5, 5 and 9, 5, 13 and 8, 13 and 8, 10, 11, 11 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1,2, 3, 4, 5, 6, 8, 9, 10, 13, 14, 15, 18, 19 and 20, respectively, of copending Application No. 09/669,805. Although the Claims are not identical, they are not patentably distinct from each other because they recite, *inter alia*, automatically updating remote system displays and defining rules or time profiles for bidding. This is a provisional double patenting rejection since the conflicting Claims have not yet been patented.

Applicant argues that this rejection should be withdrawn because the Claims are "entirely different" but does not explain any substantive differences. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

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F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant argues that Claim 17 links but fails to explain his reasoning.

### ***Response to Arguments***

Applicant's arguments filed May 10, 2005 have been fully considered but they are not persuasive. The arguments are addressed above in connection with the rejections.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk  
July 14, 2005

Examiner Charles Kyle

A handwritten signature in black ink, appearing to read "Charles Kyle", with a stylized flourish at the end.